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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : McManus et al.
Application No. : 10/815,588 Confirmation No. 1161
Filed : April 1, 2004
Title : APPARATUS FOR CONFIGURING
THE INTERIOR SPACE OF A VEHICLE
Group/Art Unit : 3612
Examiner : Gordon
Docket No. : RVR-P003-01 (formerly 14858-0006)

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection in the above-identified application.
No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

Review is requested for the reasons stated on the attached three (3) sheets.



Remarks

In an Office Action dated February 5, 2007, the Examiner rejected independent claim 1 as being anticipated by U.S. Patent No. 6,213,531 to Corey, by U.S. Patent No. 5,127,697 to St. Marie, by U.S. Patent No. 4,784,429 to Hodges, by U.S. Patent No. 4,133,571 to Fillios, by U.S. Patent No. 6,367,858 to Bradford, and by U.S. Patent No. 6,302,475 to Anderson.

Applicant submitted a response on April 9, 2007 discussing some of the reasons why the above references were not anticipatory references. The Examiner issued an Advisory Action dated May 1, 2007 and maintained the rejection of independent claim 1 as being anticipated by the above listed references.

After considering the Examiner's rebuttal to Applicant's arguments, Applicant submits that a *prima facie* case of anticipation has not been made by the Examiner. "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473, 43 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1997) (*citing In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)).

Claim 1

Independent claim 1 is directed to a passenger vehicle having an extension portion. Claim 1 requires, in part, "a bumper coupled to the expansion portion such that movement by the expansion portion between the retracted position and the extended position causes the bumper to move therewith." (hereinafter, "the bumper limitation"). In each rejection, the Official Action states "Webster's Ninth New Collegiate Dictionary (1990) defines a bumper as 'a device for absorbing shock or preventing damage.'" Whereas this definition is a reasonable one, the Official Action then falters in its application of this definition by vitiating the bumper limitation, which is impermissible.

For each reference, the Official Action cites a back wall or equivalent thereof of an expansion portion and states that such back wall satisfies the bumper limitation. In discussing U.S. Patent No. 6,213,531 to Corey, the Official Action states that such back walls "would serve to absorb shock to the rear portion 40 and prevent damage to the expandable cabin portion. Note for example, if a baseball or stone were accidentally thrown at portion 40 and struck element 43, element 43 would clearly absorb the shock of the ball or stone and protect

the overall structure 40 from damage." First, rear panel 43 is a part of extension 40. Accordingly, any damage to or force experienced by the rear panel 43 is inherently experienced by the greater extension 40, of which rear panel 43 is a part. Second, rear panel 43 is not described as having any force absorbing properties nor described as providing any sort of damage protection.


When repeating the rejection with respect to U.S. Patent No. 5,127,697 to St. Marie, the Official Action cites back wall 17 and states that "Clearly element 17 would serve to absorb at least some shock and prevent at least some damage to the surrounding structure of the device." Accordingly, the Official Action is stating that any material that fails to allow a perfectly elastic collision (defined as "no loss of kinetic energy") would satisfy the stated definition by "absorbing at least some shock." On the scales of matter with which the present application is dealing, applicant can not think of any collision that is perfectly elastic. Accordingly, all relevant matter in all relevant configurations would satisfy the Official Action's test of "absorbing at least some shock." Thus, the Official Action's application of their selected definition encompasses all matter and vitiates the bumper limitation. By doing so, the Official Action fails to make a reasonable interpretation. The Official Action continues to cite U.S. Patent No. 4,784,429 to Hodges, U.S. Patent No. 4,133,571 to Fillios, U.S. Patent No. 6,367,858 to Bradford, and U.S. Patent No. 6,302,475 to Anderson stating that portions thereof "would serve to absorb at least some shock." Clearly, the standard of only requiring absorbing "at least some shock" is not a proper test to determine whether something satisfies this limitation. Furthermore, a reasonable application of the Webster's definition cited by the Official Action results in all of the cited references failing to disclose the limitation at issue.

Additionally, all pending claims, except for allowed claims 24, 37, 47, 48, and 50, depend from claim 1. Thus, claims 1-3, 7, 8, 12-14, 20, 24, 25, 36, 37, and 42-55 are believed to be in condition for allowance. Such allowance is respectfully requested.

Conclusion

Applicants believe that that the rejection of claims 1-3, 7, 8, 12-14, 20, 24, 25, 36, 37, and 42-55 under 35 U.S.C. §102(b), **must be reversed** as the Official Action has failed to make a *prima facie* case of anticipation. As mentioned above, the Official Action fails to provide the term "bumper."

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 10, 2007.

D. Cwiklinski